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PTO/SB/21 (03-03)

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## TRANSMITTAL FORM

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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/923113	
	Filing Date	August 6, 2001	
	First Named Inventor	WOLF, S.	
	Art Unit	3732	
	Examiner Name	MANAHAN, T.	
Total Number of Pages in This Submission		Attorney Docket Number	01.39

ENCLOSURES (Check all that apply)			
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):	<small>IN TRIPPLICATE</small> <small>Fax Cover Sheet</small> <small>=SA POSTCARD</small>
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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Peter Giancana - 44,706
Signature	
Date	August 11, 2003

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PTO/SB/17 (05-03)

# FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 320)

## Complete if Known

Application Number	09/923113
Filing Date	Aug 6, 2001
First Named Inventor	WOLF, S.
Examiner Name	Manahan, T.
Art Unit	3732
Attorney Docket No.	01.39

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## METHOD OF PAYMENT (check all that apply)

Check  Credit card  Money Order  Other  None

Deposit Account:

Deposit Account Number	05-1320
Deposit Account Name	Estee Lauder

The Director is authorized to: (check all that apply)

Charge fee(s) indicated below  Credit any overpayments  
 Charge any additional fee(s) during the pendency of this application  
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1001 750	2001 375	Utility filing fee	
1002 330	2002 165	Design filing fee	
1003 520	2003 260	Plant filing fee	
1004 750	2004 375	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
<b>SUBTOTAL (1) (\$)</b>			

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims			
Multiple Dependent			
	-20** =	X	=
	- 3** =	X	=

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
1202 18	2202 9	Claims in excess of 20
1201 84	2201 42	Independent claims in excess of 3
1203 280	2203 140	Multiple dependent claim, if not paid
1204 84	2204 42	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
<b>SUBTOTAL (2) (\$)</b>		

\*\*or number previously paid, if greater; For Reissues, see above

## 3. ADDITIONAL FEES

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 410	2252 205	Extension for reply within second month	
1253 930	2253 465	Extension for reply within third month	
1254 1,450	2254 725	Extension for reply within fourth month	
1255 1,970	2255 985	Extension for reply within fifth month	
1401 320	2401 160	Notice of Appeal	
1402 320	2402 160	Filing a brief in support of an appeal	320
1403 280	2403 140	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,300	2453 650	Petition to revive - unintentional	
1501 1,300	2501 650	Utility issue fee (or reissue)	
1502 470	2502 235	Design issue fee	
1503 630	2503 315	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 750	2809 375	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 750	2810 375	For each additional invention to be examined (37 CFR 1.129(b))	
1801 750	2801 375	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	
Other fee (specify)			
*Reduced by Basic Filing Fee Paid			
<b>SUBTOTAL (3) (\$)</b>			320

(Complete if applicable)

Name (Print/Type)	Peter Giancarla	Registration No. (Attorney/Agent)	44706	Telephone	631-531-1193
Signature	Peter G Giancarla			Date	August 11, 2003

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Attorney Docket No.: 01.39

T-H  
8-18-03  
#17/Brief

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF APPEALS AND PATENT INTERFERENCES

In re Application of: WOLF, Shane D.

Serial No.: 09/923,113

Group Art Unit: 3732

Filed: August 6, 2001

Examiner: MANAHAN, T.

For: Stress Relieving Gel Handle Tools For Salon And Spa

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BRIEF ON APPEAL UNDER 37 CFR 1.192

Commissioner of Patents

Alexandria, VA 22313-1450

Sir:

The following constitutes Applicant's basis for appealing from the rejection of claims 14, 17-24 in the subject application.

1. Real Party in Interest. The real party in interest in this case is Aveda Corporation, the assignee of the application.
2. Related Appeals and Interferences. There are no related appeals or interferences.
3. Status of Claims. Claims 14, 17-24 remain rejected under 35 USC §103(a) and are herewith appealed. Claims 1-10, 12-13 and 15-16 were cancelled. Claim 11 was withdrawn as being directed to a non-elected species.
4. Status of Amendments. The amendment dated May 9, 2003, submitted after final rejection, has been entered.

08/14/2003 AWONDAF1 00000045 051320 09923113

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5. Summary of the Invention. The invention of the appealed claims relates to shears (Fig. 8) comprising a handle with finger loops, the finger loops having deformable grips (4) positioned on each inner diameter of the finger loops, wherein each grip comprises a deformable outer surface (4a) that is capable of receiving at least a portion of the inner diameter into itself and a viscous medium (4b) enclosed by the outer surface (Figs 1, 2). The grip may further comprise an inner surface (4c) such that the viscous medium is positioned between the inner and outer surfaces (Fig. 3). Also, the grip may comprise radially oriented webs (4d) that connect the inner and outer surfaces and define chambers (4e) in which the viscous medium is positioned and wherein each web contains at least one vent (4f) so that the viscous medium may flow between chambers (Fig. 4). Grips of this type have been disclosed in US Patent No. 5,000,599 (the McCall patent), the contents of which were incorporated by reference, in their entirety. However, the grips have, to Applicant's knowledge, only been disclosed for use on hair brushes and writing implements, not on shears.

6. Issues. The sole issue is whether claims 14, 17-24 are unpatentable as being obvious in view of the combined teachings of Tindall (US Patent No. 970,406) and McCall (US Patent No. 5,000,599).

7. Arguments.

A. Prosecution History.

The sole rejection remaining in the present application is a rejection of claims 14 and 17-24, all the pending claims, as being unpatentable under 35 USC §103(a) in view of the combination of Tindall and McCall (each cited above). The initial rejection of the claims, in the office action dated August 20, 2002 stated:

Tindall discloses the invention essentially as claimed except for the viscous material. McCall discloses a similar deformable grip having a viscous material disposed therein so that the grip will deform to the anatomical contours of the user in a custom fit manner and retain the deformation for a substantial period of time, for example at least five seconds. It would have been obvious to one skilled in the art to fill the chambers of Tindall with a viscous medium as taught by McCall et al in order that the grip will deform to the anatomical contours of the individual user in a custom fit manner and retain the deformation for a substantial period of time, for example at least five seconds.

In response to this rejection, Applicants pointed out that the Examiner failed to provide a reasoned explanation for his assertion that it would have been obvious to combine Tindall and McCall. Specifically, this rejection offered no motivation for making the combination. Applicant cited extensively from *in re Lee* (Fed. Cir., No. 00-1158, 1/18/02) to demonstrate that the examiner failed in his burden of establishing *prima facie* obviousness because he offered hindsight opinion in place of the required showing of a teaching or motivation to combine prior art references on the basis of the objective evidence of record. This response by the applicant was persuasive in that it led the Examiner to include in the next action a reasoned statement attempting to support the rejection. In that next and final office action dated February 11, 2003, the Examiner stated:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, McCall et al clearly teaches the desirability of using a viscous medium in the chamber having vents between the chamber. In col. 1, lines 52-65, McCall et al set forth some of the problems with air filled grips, namely grip's tendency to spring back immediately to its undeformed state. By filling the chambers with a viscous medium, McCall et al create a grip "that assumes a custom fit configuration when gripped for enhanced user comfort and reduced fatigue" and "retains the custom fit configuration for a substantial period of time" (col 2, lines 9-13). By retaining such configuration, "the grip can be released and regripped by the same user without undergoing significant shape change" (col 2, lines 34-38). Thus McCall et al clearly provide motivation to one skilled in the art to replace the air chambers of Tindall with chambers filled with a viscous medium.

Applicants argued that there is no suggestion in McCall that the grip of McCall would be suitable or beneficial on shears, while Tindall specifically teaches against using a grip like that of McCall because Tindall teaches that deformation after release is undesirable. The Examiner reasoned that McCall "set forth some of the problems with air filled grips" specifically identifying the "grip's tendency to spring back immediately to its undeformed state." Applicant pointed out that what is desirable in a grips for shears cannot be expected to be the same as that

which is desirable in a grips for writing implements, especially in light of the teaching of Tindall suggesting that maintaining deformation after release is undesirable.

Furthermore, the final office action was the first time the Examiner explained what he believes to be the motivation for combining references. The merits of this explanation aside, it is clear from the record that this rationale was not earlier explained and was presented for the first time in the final office action. The applicant protested the finality of the office action because clear issues for appeal could not have been established prior to knowing the Examiner's rational for the rejection, which came only after final rejection (MPEP 706.07). Applicant's protest was to no avail.

In response, and upon consideration of Applicants' reply, in the Advisory Action dated May 15, 2003, the Examiner simply states, without addressing Applicants' arguments:

McCall clearly provides motivation for modifying the grips of Tindall, and such teaching is not limited to writing instruments.

Applicants subsequently filed a Notice of Appeal, and now present their arguments on appeal.

#### B. Arguments in response to rejection under 35 USC § 103

The Examiner's assertions concerning what would have been obvious to a person of ordinary skill in the art **cannot be substituted for a reasoned explanation** based the disclosures of the cited references. This point is made quite forcefully in the recent decision, *in re Lee* (Fed. Cir., No. 00-1158, 1/18/02), a portion reproduced here, emphasis added.

"The factual inquiry whether to combine references must be thorough and searching." *Id.* **It must be based on objective evidence of record.** This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g.,

*Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998));

*In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful

attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");

In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant);

In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

**The need for specificity pervades this authority.** See, e.g.,

In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (**"particular findings must be made** as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed");

In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must **identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.** In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.");

In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "**only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**").

McCall does not provide motivation for modifying Tindall. This is because there is no suggestion in McCall that the grip of McCall would be suitable or beneficial on shears, while Tindall specifically teaches against using a grip in several respects like that of McCall.

Where the Examiner wrote, "McCall et al clearly teach[es] the desirability of using a viscous medium..." it must be remembered that McCall only taught this for writing implements, paint brushes and jeweler's tools. McCall never taught that his grip may be desirable on shears. Furthermore, where the Examiner wrote, "McCall et al set forth some of the problems with air filled grips...", it must be remembered that McCall only identified problems with air filled grips

as they had been used on writing implements. There is no suggestion in McCall that air filled grips had been a problem on shears. Therefore, there is no motivation in McCall to modify the shears of Tindall. On the other hand, there is in Tindall, a specific suggestion and motivation not to use a grip like McCall's on shears. Tindall wrote at column 2, line 111 to column 3, line 6:

Attention is called to the fact that the tubular cushions employed in connection with the eyes or loops of the shears of scissors handles may be filled with air at atmospheric pressure, **or at any greater pressure**, as may be desired, thus giving the cushion tubes any **desired resistance, the same as pneumatic tires**, or air tubes for other purposes.

Tindall teaches that the tubular cushions are filled with air, at or above atmospheric pressure. The purpose of the air at or above atmospheric pressure is to provide the desired resistance to deformation, "the same as pneumatic tires". Clearly, Tindall does not want grips that maintain a deformation after being released. Tindall specifically finds desirable grips that offer resistance against the hand of the user. While McCall teaches that a grip that maintains its deformation is suitable for a writing implement, Tindall teaches the opposite regarding shears. This may be because writing implements and shears are used differently. Writing implements are gripped firmly with steady pressure during use. Shears, on the other hand are repeatedly opened and closed, alternately applying pressure to the finger loops and then relaxing that pressure. It may be (Tindall does not say) that the resistance provided by the air filled tubes aids in opening the shears. At any rate, Tindall specifically teaches against the grip of McCall in relation to shears. Looked at another way, if a viscous medium is put inside the tubular grips of Tindall in accordance with the teaching of McCall, Tindall's grips will have been rendered inoperative for their intended purpose, i.e. the grips will be unable to provide the desired resistance to deformation. In conclusion, claims 14, 17-24 are not obvious over Tindall in view of McCall because there is no motivation to combine, because Tindall teaches away from McCall and because the primary reference would be rendered inoperative for its intended purpose.

## CONCLUSION

Applicants have shown, by the foregoing arguments and citations, that the PTO has not borne its burden of establishing obviousness of claims 14, 17-24 of the present application. Applicants therefore respectfully request that the Board reverse the holding of obviousness under 35 USC §103(a), and pass the present claims to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Giancana". The signature is fluid and cursive, with a large oval flourish at the beginning.

Peter Giancana, Reg.No. 44,706  
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Appendix: The appealed claims

14. Shears comprising:
  - a head that contains one or more elements adapted to be directed toward the hair;
  - a handle comprising finger loops, each finger loop having an inner diameter; and
  - deformable grips located on each inner diameter, each grip having:
    - a deformable outer surface capable of receiving at least a portion of the inner diameter into itself; and
    - a viscous medium enclosed by the outer surface.
17. The shears of claim 14 in which each grip further comprises an inner surface positioned so that the viscous medium is located between the inner and outer surfaces.
18. The shears of claim 14 in which the viscous medium is a putty.
19. The shears of claim 18 in which the viscous medium is a vinyl elastomer or silicone-based putty.
20. The shears of claim 14 in which the viscous medium is a room-temperature curable substance.
21. The shears of claim 17 in which each deformable grip further comprises radially oriented webs that connect the inner and outer surfaces and that define chambers which contain the viscous medium, wherein each web contains at least one vent.
22. The shears of claim 21 in which the viscous medium is a flowable substance.
23. The shears of claim 22 in which the viscous medium is a silicone lubricant.
24. The shears of claim 14 wherein each grip comprises a groove that receives at least a portion of the inner diameter into itself, the groove being formed by folding the grip in on itself.